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Atty Dkt. No.: 10031033-1
USSN: 10/828,892**REMARKS**

Claims 1-33 are pending. Claims 1-9 and 26-29 were examined and rejected.
The claims are not amended.
Reconsideration of this application is respectfully requested.

Rejections withdrawn

The Examiner's decision to withdraw the rejections under 35 U.S.C. § 102(b) over Pinkel, Brennan and Fodor is acknowledged and appreciated.

Rejection of claims under 35 U.S.C. § 112, first paragraph

Claims 25-30 are rejected as allegedly failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. The basis for this rejection is the Examiner's belief that claim 1 recites subject matter that is broader than as described in the specification as originally filed. This is a new matter rejection.

The written description requirement of 35 U.S.C. § 112, first paragraph, involves the question of whether the subject matter of a claim conforms to the disclosure of an application as filed. According to the MPEP, an objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed?"¹ The subject matter of the claim need not be described literally (i.e. using the same terms or *in haec verba*) in order for the disclosure to satisfy the written description requirement. Likewise, MPEP states that newly added claim limitations may be supported by disclosure that is express, implicit, or inherent.²

¹ See MPEP § 2163.02, citing *In re Gosteli* 872 F.2d 1008, 1012 (Fed. Cir. 1989).

² MPEP § 2163: "The written description requirement prevents an applicant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims, which introduce elements or limitations, which are not supported by the as-filed disclosure, violate the written description requirement... While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. (emphasis added)

Atty Dkt. No.: 10031033-1
USSN: 10/828,892

In attempting to establish this rejection, the Examiner argues that an oligonucleotide that specifically binds to a structural region of a single chromosome of a mammalian cell and does not specifically bind to structural regions of other chromosomes of the cell is not described in the specification as filed.

The Applicants submit, however, that the claim recited oligonucleotide is described throughout the specification, for example on page 11, line 21 to page 12, line 2; page 9, lines 28-32; page 13, line 29 and page 14, lines 13-16, among other places. Since support for a claim may be express, implicit or inherent, and need not be *in haec verba*, the Applicants submit that the claims are adequately described.

The Examiner appears to be seeking *explicit* support for the recited oligonucleotide. However, MPEP makes it very clear that support for a claim need not be explicit.

In view of the foregoing discussion, the Applicants submit that the current claims recite subject matter that is no broader than as described in the specification as originally filed. As such, the Applicants believe that the written description requirement of 35 U.S.C. § 112, first paragraph, has been satisfied, and no new matter is added.

Withdrawal of this rejection is requested.

Rejection of claims under 35 U.S.C. § 102

Claims 1-9 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Bao et al. (US Publication No. 2001/0018183). The Applicants respectfully traverse this rejection.

According to the M.P.E.P., a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. See M.P.E.P. § 2131.

Atty Dkt. No.: 10031033-1
USSN: 10/828,892

Claim 1 is directed to an array that includes at least one chromosome structural region *oligonucleotide* feature, where the feature contains *oligonucleotide* that specifically binds to a structural region of a single chromosome of a mammalian cell and does not specifically bind to structural regions on other chromosomes of the mammalian cell.

The Applicants submit that Bao fails to explicitly disclose an array containing *oligonucleotides* that specifically bind to a structural region of a single chromosome and do not specifically bind to structural regions on other chromosomes. As such, the Applicants submit that Bao fails to disclose each and every element of the rejected claims, and this rejection should be withdrawn.

In the Office Action, the Examiner points towards ¶134 on page 10 and ¶45 on page 3 of Bao's disclosure as disclosing an array comprising the oligonucleotide recited in the instant claims. This is not the case, however, since neither of the paragraphs that the Examiner points towards contains any discussion of oligonucleotides, which are a requirement of the rejected claims.

In view of the foregoing discussion, the Applicants submit that Bao's array is not the same as the claimed array and, as such, Bao cannot anticipate the claims.

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 26-29 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bao et al. in view of Ahern (The Scientist (1995) 9:20)).

According to the MPEP § 706.02 (j), to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Claims 26-29 ultimately depend from Claim 1 and thus requires an array containing an oligonucleotide feature, where the feature contains an *oligonucleotide*

Atty Dkt. No.: 10031033-1
USSN: 10/828,892

that specifically binds to a structural region of a single chromosome of a mammalian cell and does not specifically bind to structural regions on other chromosomes of the mammalian cell.

As noted above, Bao is deficient for not providing array containing such an *oligonucleotide* feature. Ahern is cited to provide a kit.

Since Ahern's kit fails to fill Bao's deficiency, the combination of Bao and Ahern fail to teach or suggest an element of the rejected claims.

In view of the foregoing discussion, the Applicants submit that a *prima facie* case of obviousness has not been established, and this rejection may be withdrawn.

JUL 11 2007

Atty Dkt. No.: 10031033-1
USSN: 10/828,892**CONCLUSION**

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Gordon Stewart at (408) 553-2986.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10031033-1.

Respectfully submitted,

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